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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,319	12/19/2001	Kouzo Nagashima	SHO 1007-01US	8141

28327 7590 10/04/2004

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EXAMINER

HARRISON, JESSICA

ART UNIT PAPER NUMBER

3714

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/025,319

Applicant(s)

NAGASHIMA, KOUZO

Examiner

Jessica J. Harrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,4,6-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4,6-13,15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/7/04 and 8/9/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 24, 2004 (Amendment) and May 27, 2004 (IDS) have been entered.

Claims 2, 4, 6-13 and 15 are pending. Claims 2 and 7-10 have been amended. Note change in examiner in charge of the application.

### ***Claim Rejections - 35 USC § 112***

Claims 8 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is a question as to the scope of instant claims 8 and 4 in that they recited a memory structure having program "configured to" [perform functions]. This is not a clear means-plus-function invocation, raising the question of the function being descriptive of and limiting to the storage technology. Given that preambles can not be used to breath life and meaning into a claim, one could construe claim 8 to recite a program storage medium comprising an activation program and a notification program, with no elaboration as to what these programs encompass. The language 'configured such that when' is setting

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forth a conditional possibility, rather than positively linking the function to any program. Similarly, the language 'being configured' is not clearly stating that a function is accomplished by the program. Rather than assert applicant is merely claiming a program per se on a storage medium, which would fail to pass muster under section 101, the examiner feels a statutory invention exists and the issue revolves around the true scope of the claim. Applicant has not clearly and properly defined his computer related invention. It is suggested applicant consider means plus function language or other language to reflect the useful, concrete and tangible nature of the computer software related invention so that no question of true scope can be raised. Review of MPEP 2106 is suggested for assistance.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2,4,6-12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miura in view of Begis.

The rejection contained in the prior office action is maintained and incorporated herein. Regarding the newly added language to claims 7-9, noting at least Figure 6 of Begis one can readily see that each player profile, which can

result in the creation of a Proxy player, has different percentages for actions to be accomplished in the game. Therefore, they appear to have different thinking routines to the player who is playing opposite them. A proxy player based upon profile 50 will have a much slower combat response time than a proxy player based upon profile 60. These profiles are applying different data into the game program and therefore simulate different players. Therefore, the combination as previously set forth includes the newly added language at least as much as to the specificity claimed.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miura in view of Begis as applied to claim 7 above, and further in view of Luciano Jr. The rejection contained in the prior office action is maintained and incorporated herein.

### ***Response to Arguments***

Applicant's arguments filed May 24, 2004 have been fully considered but they are not persuasive. In support of patentability, applicant submits that the language has been added to bring out the fact that the appearance of an opponent, due to their different thinking routines, provides a different game. This appears to be in response to the prior examiner's comment that the appearance of an opponent does not change the operation of the game. The instant examiner can not speak to the prior examiner's position but does note that in the present understanding of the invention, claims, and prior art it is felt that the combination of Miura in view of Begis includes that added claimed

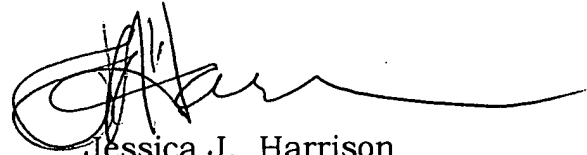
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limitations. This examiner acknowledges that the appearance of an opponent will change aspects of a game (Chess will remain chess, but strategy employed will be dependent upon opening move, second move, etc.). When there is no player in Miura available, a computer opponent will be substituted. Begis teaches that simulated opponents, based upon profiles (each of which is different) produce advantages over (knowingly) playing against a computer. Each avatar is based upon simulative skill and therefore will appear to have a 'thinking routine'.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica J. Harrison whose telephone number is 703-308-2217. The examiner can normally be reached on M-F during business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'J. Harrison', with a long horizontal flourish extending to the right.

Jessica J. Harrison  
Primary Examiner  
Art Unit 3714

jjh